

**REMARKS**

Claims 1 through 20 are pending in this application. Claim 6 is amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

**I. Claim Rejections - 35 USC § 112**

The Examiner rejected claims 6-9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation “said switching unit” in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claims 7-9 are rejected due to their dependency on the claim 6.

Claim 6 has been amended accordingly.

**II. Claim Rejections - 35 USC § 103**

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria

must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**A. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheney et al. U.S. Pat. No. 6,519,283 (hereinafter Cheney'283) and Cheney et al. U.S. Patent No. 6,469,743 (hereinafter Cheney'743). The Applicant respectfully traverses.**

The Examiner states that concerning claim 1, an output unit (e.g., the output 110 of Fig. 4) directly connected to said digital to analog converter (directly connected to DENC 107 of Fig. 4) and connected to said signal dispensing unit (connected to the computer TV output for receiving the analog video signal 104 from the computer TV output unit which dispenses the analog video signal) of said personal computer, receiving said first analog signal from said signal dispensing unit

The Examiner admits that is unclear whether Cheney'283 teaches an outputting unit directly connected to said signal dispensing unit of said personal computer.

However, the Examiner argues that Cheney'283 discloses that the analog video signal 104 is received by the decoder system chip 100 and directly being forwarded to the output 110 because Cheney'283 discloses in column 7, lines 19-38 that the host processor can set the pixel select control to (3) support picture-in-picture display, dynamically selecting both the decompressed and uncompressed video for display and in mode (3), switching between decompressed and uncompressed video for simultaneous display is done at a rate according to the desired location of the secondary picture 72. Although, the Examiner admits that the output 110 is not visually directly connected to the signal dispensing unit, there is a direct mechanism/connection between the signal source (i.e., the computer signal having TV output) and the output 110 so that the video signal is being forwarded and that forwarding means that the video signal from the dispensing unit is being directly sent to the output unit 110.

However, Cheney '283 does not only "not clearly" teach a direct connection between the outputting unit and the dispensing unit, but simply fails to make such a teaching. Looking at figure 4, it is clear that reference 110 has no direct connection with a dispensing unit for a personal computer as signal 104 which is connected to 105 is not directly connected to an outputting unit. There must be an actual direct connection and not a conjecture of forwarding means, which if used is no longer "direct connection." There is no actual teaching or suggestion being made.

The Examiner argues that the video signal is being forwarded and that forwarding means that the video signal from the dispensing unit is being directly sent to the output unit 110. However, the claim indicates a "direct" physical connection between an outputting unit and the dispensing unit and

a signal being forwarded through different units is clearly not the same.

The Examiner goes on to argue that Cheney'743 teaches an outputting unit outputting said analog personal computer signal generated from said signal dispensing unit, where said signal dispensing unit dispenses an output signal output from a personal computer in the form of an analog signal (See Cheney'743 column 11-12).

However, Cheney '743 also does not teach a direct connection between the personal computer dispensing unit and the outputting unit. As mentioned in MPEP §706.02(j), the prior art reference (or references when combined) must teach or suggest all the claim limitations. Here it is clear that not all the limitations are disclosed.

In addition, the Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964). Here, there is no actual teaching of a direct connection between the dispensing unit and the outputting unit.

Moreover, the Examiner refers to reference 110 as an outputting unit, but 110 is only the output signal as mentioned in Cheney '283 by col. 6, line 50. This is clearly not an outputting unit as also seen in figure 4 as the reference 110 merely refers to the output arrow from the DENC 107 to the television.

In addition to the above arguments for claim 1, in claim 6, Cheney'283 teaches a method for processing a signal, the first analog signal is sent to the switching unit without conversion.

The Examiner argues that although the output 110 is not visually directly connected to the signal dispensing unit, there is a direct mechanism/connection between the signal source, i.e., the computer signal having TV output, and the output 110 so that the video signal is being forwarded. The Examiner argues that the forwarding means that the video signal from the dispensing unit is being directly sent to the output unit 110), with the first analog signal being sent to said switching unit (“said switching unit” lacks antecedent basis) without conversion (column 7, lines 19-38).

However, col. 7, lines 19-38 is a modified video decoder from figure 4 so there is an on screen display , which then modifies from the other portions the Examiner are disclosed. Moreover, col. 7, lines 19-38 talks of forwarding the decompressed video and the uncompressed video through a MUX which does not mean that necessarily that is without conversion or that is directly sent to the outputting unit which the Examiner refers to as reference 110.

Concerning claims 6 and 10, the signal 104 which the Examiner refers to be coming from . the dispensing unit which is not disclosed, does not send to both the A/D converter and the outputting unit. Figure 4 only discloses the signal 104 going to the television decoder 105.

Further concerning claims 1, 2 and 10 in addition to above arguments for claims 1 and 6, the

actual signal dispensing unit is not disclosed by the combination of references. The Examiner refers to a signal of a television signal from a personal computer, but it is only the signal that is disclosed. There is no disclosure of the dispensing unit and its particular connections in relation to the other units as it is directly connected to the analog to digital converter and/or directly connected to the outputting unit and the direct connection or embodiment within the personal computer. The actual structure must be taught or suggested and a simple statement of the signal is not enough to teach or suggest all the different connections a unit has.

Concerning claims 17 and 18, there is no signal dispensing unit directly connected to the switching unit as shown above. The Examiner clearly admits that Cheney '283 does not clearly show such a limitation and neither does Cheney '743. Moreover, there is no actual disclosure of the dispensing unit itself with its connections in relation with the personal computer, the converter and the switching unit.

Concerning claim 19, the references fail to teach or suggest the signal processing unit being directly connected to the second converter unit or the second converter unit being directly connected to the switching unit. Cheney '283 in figures 3-6, col. 7, lines 19-67, col. 8, lines 1-67, col. 9, lines 1-8 and figure 5 do not teach or suggest such a connection.

Respectfully, the Examiner failed to discuss how such direct connections are taught or suggested by the references.

Concerning claim 20, the references fail to teach or suggest the scan rate conversion unit directly connected between the decoding unit and the signal processing unit. Cheney'283 in figures 5-6, col. 7, lines 19-67, col. 8, lines 1-67 and col. 9, lines 1-8 fails to teach or suggest such direct connections and the Examiner, respectfully, failed to address the limitation in its entirety. Rather the Examiner only stated the conversion of signals which does not necessarily teach or suggest the direct connection.

### **III. Entry of Amendments**

Entry of the foregoing amendments to claims is proper under 37 C.F.R. 1.116(b) because those amendments simply respond to the issues raised in the final rejection, no new issues are raised, no further search is required, and the foregoing amendments are believed to remove the basis of the outstanding rejections and to place all claims in condition for allowance. The foregoing amendments, and explanations, could not have been made earlier because they are merely responsive to issues newly raised in Paper No. 20050507.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
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